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EXAMINER
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BELL, MELTIN

ART UNIT	PAPER NUMBER
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2121

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6

Please find below and/or attached an Office communication concerning this application or proceeding.

SDM

## Office Action Summary

Application No.

09/973,501

Applicant(s)

KERVEN ET AL.

Examiner

Meltin Bell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 October 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☒ Claim(s) 1 and 3 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 October 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3, 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

This action is responsive to application **09/973,501** filed **10/08/01**.

Claims 1-27 have been examined.

#### ***Priority***

Applicant's claim for domestic priority against application number 60/238,566 filed **10/6/00** under 35 U.S.C. 119(e) is acknowledged.

#### ***Information Disclosure Statement***

Applicant is respectfully reminded of the ongoing Duty to disclose 37 C.F.R. 1.56 all pertinent information and material pertaining to the patentability of applicant's claimed invention, by submitting in a timely manner PTO-1449, Information Disclosure Statement (IDS) with the filing of applicant's application or thereafter.

The information disclosure statement filed 2/1/02 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because of missing or inaccurate information in the listing:

- The Lawrence et al reference is missing the date of publication.
- The Osborn et al reference is missing the month of publication.
- The Larkey reference is missing the month of publication.

It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement

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or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

### ***Oath/Declaration***

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

- It does not state that the persons making the oath or declaration believe the named inventors to be the original, first and sole inventors of the subject matter which is claimed and for which a patent is sought.
- It does not identify the provisional application 60/238,566 filed 10/6/00 on which priority is claimed.

### ***Drawings***

The United States Patent and Trademark Office of Draftsperson's Patent Drawings Review have reviewed the formal drawings.

The drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is required in correcting any errors of which applicant may become aware in the drawings.

The drawings are objected to because:

- Fig. 1, items 130 and 140 are missing the names on page 9, lines 6-7.

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- The arrow from step 215 in Fig. 2A should go directly to step 225 as suggested on page 19, line 20 [215].
- Page 19, line 23 [230] suggests a mismatch in Fig. 2A's
  - o Yes branch of step 230 going to step 240 vs. [245].
  - o No branch of step 230 going to step 235 vs. [240].
- The arrow from step 245 in Fig. 2A should go directly to the circled A as suggested on page 19, line 26.
- Fig. 2C, step 325 is missing a Yes branch.
- Fig. 2D, step 355 is missing a Yes branch.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Specification***

The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is required in correcting any errors of which applicant may become aware in the specification.

The disclosure is objected to because of the following informalities:

- The use of the trademarks NETSCAPE™ and MICROSOFT™ have been noted in this application (specification page 2, lines 24-25 and page 10, line 1). They should be capitalized wherever they appear and be accompanied by the generic terminology. Although the use of trademarks is permissible in patent

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applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

- The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code (page 2, lines 11-13). Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

Appropriate correction is required.

### ***Claim Objections***

Claims 1 and 3 are objected to because of the following informalities:

#### **Regarding claim 1, limitation b:**

- 'other ~~an~~ the' would read better as 'other and the'

#### **Regarding claim 3, limitation b:**

- 'other ~~an~~ the' would read better as 'other and the'

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 11 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 11 recites the limitation "steps (d)" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 23 cannot depend on itself as indicated on line 1, "The method of claim 23..."

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the Office presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the Office to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Jain et al* U.S. Patent Number 5,983,237 (November 9, 1999) in view of *Rivette et al* U.S.

Patent Number 5,754,840 (May 19, 1998) and in further view of *Doyle* U.S. Patent Number 6,009,455 (December 28, 1999).

**Regarding claim 1:**

*Jain et al* teaches,

- (a) a data store comprising one or more storage elements (Fig. 1, item 112)
- (b) one or more processors in communication with each other and the data store (Fig. 1, item 102), the one or more processors for:
  - (i) receiving the target mark comprising one or more mark terms (Figs. 2, 3)
  - (ii) creating a search phrase by (Figs. 4, 8-10C)
    - (1) initializing the search phrase to include the mark terms (Fig. 8, items 370, 372)
    - (2) identifying variations for any of the mark terms, wherein the identified variations are of a type selected from the group consisting of homonyms, translations and common misspellings (Fig. 10A, items 406, 408, 432, 434)
    - (3) if any variations were identified, adding the identified variations to the initialized search phrase (Fig. 10A, items 410, 436)
  - (iii) generating a search result set by (Figs. 3-4, 8, 10A-C, 12-13B):
    - (1) conducting one or more searches in one or more accessible information storage systems based upon the created search phrase (Fig. 3)
    - (2) accumulating results from each of the conducted searches in the search result set (Fig. 4)



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- (iv) storing the search result set in the data store (Fig. 2, item 134, 112; Fig. 3 items 156, 158; Fig. 12; column 15, lines 35-37, "Proceeding to state...a RAW-RESULT matrix"; column 10, lines 62-64, "The database 112...are stored therein")

- (v') prioritizing the elements of the search result set (Fig. 3, items 156 to 158 to 162; Fig. 4, items 210 to 212; Fig. 8, items 314 to 210; Fig. 13B)

However, *Jain et al* doesn't explicitly teach generating a report based upon the search result set or transmitting the report to an output device while *Rivette et al* teaches,

- (vi) generating a report based upon the search result set (Fig. 17; Fig. 27, item 2708)

- (vii) transmitting the report to an output device (Fig. 27, item 2706)

*Doyle* teaches,

- (iv) storing the search result set in the data store (Abstract, sentence 6, "An application-independent client...the master computer")

Motivation – The portions of the claimed system would have been a highly desirable feature in this art for

- Maximizing diversity of the results (*Jain et al*, column 9, lines 40-43, "The purpose of...broad as possible")
- Verifying consistency of terminology within a document (*Rivette et al*, column 1, lines 40-44, "The present invention...verify terminology consistency")
- Increasing productivity while tolerating failures (*Doyle*, column 1, lines 46-56, "The present invention...as the Internet")

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to combine *Jain et al* with *Rivette et al* and *Doyle* to obtain the

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invention specified in claim 1, a system for locating references related to an actual or potential target mark in one or more accessible information storage systems. The modification would have been obvious because one of ordinary skill in the art would have been motivated to locate as many relevant references as possible even when inconsistencies exist in the documents or the network information storage systems.

**Regarding claim 2:**

The rejection of claim 1 is incorporated. Claim 2's further limitations are taught in

*Rivette et al*:

- the one or more storage elements comprises at least one storage element that stores data on removable media (Fig. 1, item 114)

Therefore, claim 2 is rejected under the same rationale as claim 1.

**Regarding claim 3:**

*Jain et al* teaches,

- (a) a data store comprising one or more storage elements (Fig. 1, item 112)
- (b) One or more processors in communication with each other and the data store (Fig. 1, item 102), the one or more processors for:
  - (i) receiving one or more phrases, wherein each received phrase comprises one or more terms (Figs. 2, 3)
  - (ii) for each received phrase, creating an expanded search phrase by (Figs. 4, 8-10C):
    - (1) initializing the expanded search phrase to include the terms of respective received phrase (Fig. 8, items 370, 372)

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- (2) identifying synonyms for any term within the respective received phrase (Fig. 10A, items 406, 408, 432, 434)

- (3) if any synonyms were identified, adding the identified synonyms to the initialized expanded search phrase (Fig. 10A, items 410, 436)

- (iii) generating a search result set by (Figs. 3-4, 8, 10A-C, 12-13B):

- (1) for each expanded search phases, conducting one or more searches in one or more accessible information storage systems based upon the respective expanded search phrase (Fig. 3)

- (2) accumulating results from each of the conducted searches in the search result set (Fig. 4)

- (iv) storing the search result set in the data store (Fig. 2, item 134, 112; Fig. 3 items 156, 158; Fig. 12; column 15, lines 35-37, "Proceeding to state...a RAW-RESULT matrix"; column 10, lines 62-64, "The database 112...are stored therein")

- (v) prioritizing the elements of the search result set (Fig. 3, items 156 to 158 to 162; Fig. 4, items 210 to 212; Fig. 8, items 314 to 210; Fig. 13B)

However, *Jain et al* doesn't explicitly teach each received phrase represents a limitation of the target claim, generating a report based upon the search result set or transmitting the report to an output device while *Rivette et al* teaches,

- (i) receiving one or more phrases, wherein each received phrase represents a limitation of the target claim and comprises one or more terms (Fig. 7, item 708)

- (vi) generating a report based upon the search result set (Fig. 17; Fig. 27, item 2708)

- (vii) transmitting the report to an output device (Fig. 27, item 2706)

*Doyle* teaches,

- (iv) storing the search result set in the data store (Abstract, sentence 6, "An application-independent client...the master computer")

Motivation – The portions of the claimed system would have been a highly desirable feature in this art for

- Maximizing diversity of the results (*Jain et al*, column 9, lines 40-43, "The purpose of...broad as possible")
- Verifying consistency of terminology within a document (*Rivette et al*, column 1, lines 40-44, "The present invention...verify terminology consistency")
- Increasing productivity while tolerating failures (*Doyle*, column 1, lines 46-56, "The present invention...as the Internet")

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to combine *Jain et al* with *Rivette et al* and *Doyle* to obtain the invention specified in claim 3, a system for locating references related to a patent or proposed for a patent application target claim in one or more accessible information storage systems. The modification would have been obvious because one of ordinary skill in the art would have been motivated to locate as many relevant references as possible even when inconsistencies exist in the documents or the network information storage systems.

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**Regarding claim 4:**

The rejection of claim 3 is incorporated. Claim 4's further limitations are taught in

*Rivette et al*:

- the one or more storage elements comprises at least one storage element that stores data on removable media (Fig. 1, item 114)

Therefore, claim 4 is rejected under the same rationale as claim 3.

**Regarding claim 5:**

*Jain et al* teaches,

- (a) receiving one or more search phrases associated with the target item, wherein each received search phrase comprises one or more search terms (Figs. 2, 3)
- (b) for each received phrase, creating an expanded search phrase by (Figs. 4, 8-10C)
- (i) initializing the expanded search phrase to include the search terms of respective received search phrase (Fig. 8, items 370, 372)
- (ii) identifying variations for any search term within the respective received phrase (Fig. 10A, items 406, 408, 432, 434)
- (iii) if any variations were identified, adding the identified variations to the initialized expanded search phrase (Fig. 10A, items 410, 436)
- (c) generating a search result set by (Figs. 3-4, 8, 10A-C, 12-13B):
- (i) for each expanded search phases, conducting one or more searches in one or more accessible information storage systems based upon the respective expanded search phrase (Fig. 3)

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- (ii) accumulating results from each of the conducted searches in the search result set (Fig. 4)

However, *Jain et al* doesn't explicitly teach generating a report based upon the search result set or transmitting the report to an output device while *Rivette et al* teaches,

- (vi) generating a report based upon the search result set (Fig. 17; Fig. 27, item 2708)
- (vii) transmitting the report to an output device (Fig. 27, item 2706)

Motivation – The portions of the claimed method would have been a highly desirable feature in this art for

- Maximizing diversity of the results (*Jain et al*, column 9, lines 40-43, “The purpose of...broad as possible”)
- Verifying consistency of terminology within a document (*Rivette et al*, column 1, lines 40-44, “The present invention...verify terminology consistency”)

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to combine *Jain et al* with *Rivette et al* to obtain the invention specified in claim 5, a method for locating references related to an actual or proposed target intellectual property item target mark in one or more accessible information storage systems. The modification would have been obvious because one of ordinary skill in the art would have been motivated to locate as many relevant references as possible even when inconsistencies exist in the documents.

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**Regarding claim 6:**

The rejection of claim 5 is incorporated. Claim 6's further limitations are taught in

*Rivette et al*:

- (i) receiving a document selected from the group consisting of a patent, a patent application, a trademark registration and a trademark registration application (Abstract, sentences 1-3, "A system and...a patent application")
- (ii) extracting the one or more search phrases from the received document (Abstract, sentences 4-6, "The user then...displays these terms")

Therefore, claim 6 is rejected under the same rationale as claim 5.

**Regarding claim 7:**

The rejection of claim 6 is incorporated. Claim 7's further limitations are taught in:

*Rivette et al*,

- (iii) receiving a reference to the document (Fig. 4, item 402)

*Doyle*,

- (iv) transmitting a request for the document to an information storage system based upon the received reference (Abstract, sentences 5-6, "An application-independent master...the master computer")

Therefore, claim 7 is rejected under the same rationale as claim 6.

**Regarding claim 8:**

The rejection of claim 1 is incorporated. Therefore, claim 8 is rejected under the same rationale as claim 1.

**Regarding claim 9:**

The rejection of claim 1 is incorporated. Claim 9's further limitations are taught in:

*Rivette et al*,

- storing the generated report in a data store (Fig. 27, item 2706)

Therefore, claim 9 is rejected under the same rationale as claim 1.

**Regarding claim 10:**

The rejection of claim 1 is incorporated. Claim 10's further limitations are taught in:

*Rivette et al*,

- the generated report comprises one or more fields that upon receipt by the output device allow a user to edit contents of the one or more fields (Figs. 3-5, 7, 17, 10)
- (f) receiving one or more modifications to the report corresponding to input by the user into the one or more fields (Fig. 22)
- (g) modifying the report or the search results set based upon the received one or more modifications (Fig. 27)

Therefore, claim 10 is rejected under the same rationale as claim 1.

**Regarding claim 11:**

The rejection of claim 10 is incorporated. Therefore, claim 11 is rejected under the same rationale as claim 10.

**Regarding claim 12:**

The rejection of claim 1 is incorporated. Therefore, claim 12 is rejected under the same rationale as claim 1.



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**Regarding claim 13:**

The rejection of claim 12 is incorporated. Claim 13's further limitations are taught in:

*Jain et al*,

- (i) calculating a correspondence value between each element of the search result set and each of the one or more descriptions (Fig. 9, item 358)
- (ii) sorting the elements of the search result set based upon the calculated correspondence values (Figs. 13B, 16A, items 766, 772)

Therefore, claim 13 is rejected under the same rationale as claim 12.

**Regarding claim 14:**

The rejection of claim 12 is incorporated. Claim 14's further limitations are taught in:

*Rivette et al*,

- (i) calculating a correspondence value between each element of the search result set and the technical descriptions (Figs. 7, 10)

*Jain et al*,

- (ii) sorting the elements of the search result set based upon the calculated correspondence values (Figs. 13B, 16A, items 766, 772)

Therefore, claim 14 is rejected under the same rationale as claim 12.

**Regarding claim 15:**

The rejection of claim 12 is incorporated. Claim 15's further limitations are taught in:

*Rivette et al*,

- (i) calculating a frequency count associated with each element of the search result set (Figs. 7, 10)

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- sorting document terms (Fig. 25, item 2506)

*Jain et al,*

- (ii) sorting the elements of the search result set based upon the calculated frequency count (Figs. 13B, 16A, items 766, 772)

Therefore, claim 15 is rejected under the same rationale as claim 12.

**Regarding claim 16:**

The rejection of claim 15 is incorporated. Therefore, claim 16 is rejected under the same rationale as claim 15.

**Regarding claim 17:**

The rejection of claim 15 is incorporated. Therefore, claim 17 is rejected under the same rationale as claim 15.

**Regarding claim 18:**

The rejection of claim 1 is incorporated. Claim 18's further limitations are taught in:

*Rivette et al,*

- the target item is a claim (Fig. 7, item 708)
- the receiving step comprises receiving a single search phrase comprising the mark (Fig. 5, items 512, 516)

Therefore, claim 18 is rejected under the same rationale as claim 1.

**Regarding claim 19:**

The rejection of claim 18 is incorporated. Therefore, claim 19 is rejected under the same rationale as claim 18.

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**Regarding claim 20:**

The rejection of claim 18 is incorporated. Claim 20's further limitations are taught in:

*Jain et al*,

- attempting to create additional expanded search phrases by selectively parsing and regrouping the one or more search terms of the received single search phrase (Fig. 3, item 154; Fig. 4, item 204; Fig. 8, item 312, 314, 316, 318, 202; )

Therefore, claim 20 is rejected under the same rationale as claim 18.

**Regarding claim 21:**

The rejection of claim 18 is incorporated. Claim 21's further limitations are taught in:

*Rivette et al*,

- the generated report is selected from the group consisting of a draft registrability analysis, draft infringement analysis, a draft office action and a table of results (Figs. 5, 10)

Therefore, claim 21 is rejected under the same rationale as claim 18.

**Regarding claim 22:**

The rejection of claim 1 is incorporated. Claim 22's further limitations are taught in:

*Rivette et al*,

- the target item is a claim (Fig. 4, item 406)
- receiving a search phrase corresponding to each limitation of the claim (Fig. 7, item 708)

Therefore, claim 22 is rejected under the same rationale as claim 1.

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**Regarding claim 23:**

*Jain et al*, *Rivette et al* and *Doyle's* teachings above are incorporated. Claim 23's further limitations are taught in:

*Jain et al*,

- identifying synonyms (Fig. 10A, items 406, 408, 432, 434)

Therefore, claim 23 is rejected under the same rationale as claims 1-22.

**Regarding claim 24:**

The rejection of claim 23 is incorporated. Claim 24's further limitations are taught in:

*Rivette et al*,

- the generated report is selected from the group consisting of a table of results, a draft patentability analysis, a draft infringement analysis, a draft invalidity analysis, a draft office action, a draft search report and a draft written opinion (Title, "System, Method, and... Specification and Claims"; Figs. 5, 10)

Therefore, claim 24 is rejected under the same rationale as claim 23.

**Regarding claim 25:**

The rejection of claim 23 is incorporated. Therefore, claim 25 is rejected under the same rationale as claim 23.

**Regarding claim 26:**

The rejection of claim 23 is incorporated. Therefore, claim 26 is rejected under the same rationale as claim 23.

**Regarding claim 27:**

*Jain et al* teaches,

- (a) one or more processors (Fig. 1, item 102)
- (i) selectively receiving one or more search terms (Figs. 2, 3)
- (ii) expanding the one or more search terms to create a search data set (Figs. 4, 8-10C)

However, *Jain et al* doesn't explicitly teach networked processors or intellectual property while *Rivette et al* teaches

- (b) an intellectual property search engine resident on the one or more processors, the intellectual property search engine (Abstract, "A system and ... in the specification"):
- (iii) performing one or more searches of at least one potential intellectual property reference data set (Fig. 7, items 706, 708)
- (iv) comparing the search data set to the potential intellectual property reference data set (Fig. 20, item 2012, 2014)
- (v) returning potential intellectual property reference data sets based upon the comparison between the search data set and the potential intellectual property reference data set (Fig. 20, items 2016, 2022)

*Doyle* teaches,

- (a) one or more processors in selective communication with the network (Figs. 1-2f)
- (iii) performing one or more searches of at least one potential intellectual property reference data set via the network (Abstract, sentences 6-7, "An application-independent client... a specified range")

Motivation – The portions of the claimed system would have been a highly desirable feature in this art for

- Maximizing diversity of the results (*Jain et al*, column 9, lines 40-43, “The purpose of...broad as possible”)
- Verifying consistency of terminology within a document (*Rivette et al*, column 1, lines 40-44, “The present invention...verify terminology consistency”)
- Increasing productivity while tolerating failures (*Doyle*, column 1, lines 46-56, The present invention...as the Internet”)

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to combine *Jain et al* with *Rivette et al* and *Doyle* to obtain the invention specified in claim 27, a system for locating references within one or more network accessible data sets comprising potential intellectual property references. The modification would have been obvious because one of ordinary skill in the art would have been motivated to locate as many relevant references as possible even when inconsistencies exist in the intellectual property documents or the network data sets.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- *Jain et al*; U.S. Patent Number 5,983,237
- *Rivette et al*; U.S. Patent Number 5,754,840
- *Doyle*; U.S. Patent Number 6,009,455

- *Buickel et al*; U.S. Patent Number 5,740,362; Management of a Network Distributed Agents in a Distributed Computing Environment
- *Ahn*; U.S. Patent Number 5,848,409; System, Method and Computer Program Product for Maintaining Group Hits Table and Document Index Tables for the Purpose of Searching Through Individual Documents and Groups of Documents
- *Robins*; U.S. Patent Number 5,392,428; Text Analysis System
- *Siegel*; U.S. Patent Number 5,799,267; Phonic Engine
- *Hendricks et al*; U.S. Patent Number 5,893,088; System and Method for Performing Database Query Using a Marker Table
- *Lee*; U.S. Patent Number 6,662,178; Apparatus for and method of searching and organizing intellectual property information utilizing an IP thesaurus
- *Lee et al*; U.S. Patent Number 6,694,331; Apparatus for and method of searching and organizing intellectual property information utilizing a classification system
- *Bradford et al*; U.S. Patent Application Publication 2002/0103799; Method for document comparison and selection
- *Adler et al*; U.S. Patent Application Publication 2003/0033295; Method for analyzing and recording innovations
- *Larkey*; A Patent Search and Classification System; Proceedings of the fourth ACM conference on Digital libraries; August 1999
- *Bollacker et al*; Discovering Relevant Scientific Literature on the Web; IEEE Intelligent Systems; Vol.: 15, Iss. 2; March-April 2000; pp 42 - 47

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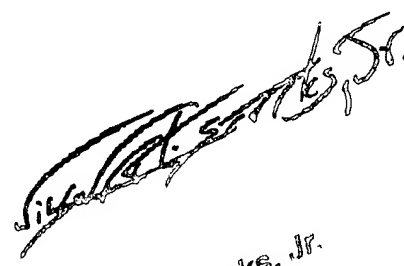
Any inquiry concerning this communication or earlier communications from the Office should be directed to Melvin Bell whose telephone number is 703-305-0362.

This Examiner can normally be reached on Mon - Fri 7:30 am - 4:30 pm.

If attempts to reach this Examiner by telephone are unsuccessful, his supervisor, Anil Khatri, can be reached on 703-305-0282. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

MB / M.B.



**Wilbert L. Starks, Jr.**  
**Primary Examiner**  
**Art Unit - 2121**